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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,841

11/25/2005

Michael Burmester

H01.2-12068

3686

490 7590 03/14/2007
VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

MORAN, KATHERINE M

ART UNIT

PAPER NUMBER

3765

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/549,841

Applicant(s)

BURMESTER, MICHAEL

Examiner

Katherine Moran

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment of 1/2/07 has been received and reviewed. Applicant amended claims 7 and 8 and submitted new claim 12. Claims 1-12 are pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the imprinted foils injected into the plastic material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 3, 8, and 12 are objected to because of the following informalities: claim 3: insert --and-- after "portion,"; claim 8: the claim should be amended in proper Markush format as follows: pigments selected from the group consisting of: dye pigments, effect pigments, phosphorescing and/or fluorescing pigments, metallic and/or glittering pigments, and metal oxide mica pigments; claim 12: insert --foils-- after "imprinted". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite due to the recitation "is realised". It is not clear what this phrase is reciting. Claim 8 recites "pigments are incorporated

into the plastic material". It is unclear what process is denoted by the term "incorporated".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fay (U.S. 4,192,017). Fay discloses the invention as claimed. Fay teaches a hat part 10 or 14 and visor part 12 made of a plastic material. With regard to the performance properties of the claimed plastic as recited in claims 1 and 9-11, Applicant's claims recite a plastic hat part. Thus, any hat part formed from plastic is expected to perform in the same way as outlined by claims 1, 10, and 11. Fay teaches that hat part 14 is formed from flexible polyurethane (col.2, lines 46-48). By definition, thermoplastic urethane based on polyether or polyester is known as polyurethane material (as disclosed in Applicant's specification, pg.3, lines 1-2). Thus, The hat part is provided as a visor part 12 or hat flap 10 which has a portion resting against the head of a person bearing the hat and a distant portion, with a hat material 18, 20, 26 attached to the resting portion. The plastic material 12 is partially or completely transparent. Regarding the recitation of "plastic material is injection moulded", the method by which the material

is formed is not given patentable weight in an apparatus claim. Fay's plastic material is capable of being injection moulded.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Bree (U.S. 4,767,647). Fay discloses the invention substantially as claimed. However, Fay doesn't teach plastic material that is partially or completely metallised, or foils completely or partially injected into the plastic material. Fay's hat part includes a decorative logo 32 which may be imprinted on the visor's surface. It is common in the art to provide hat parts with emblems to achieve a desired aesthetic effect. Bree teaches an emblem formed from a decorative, embossed foil 18 that is injected with a plastic material 16. The embossed foil would result in an altered foil surface that is structurally equivalent to the surface of an imprinted foil. The process of manipulating the foil does not carry patentable significance in interpretation of an apparatus claim. Thus, whether the foil is imprinted or embossed, the resulting foil structure is the same. Therefore, it would have been obvious to provide the emblem of Bree to Fay's hat part since the emblem is easily manufactured and lends desired optical effects to the hat.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Youmans et al (Youman, U.S. 6,615,409). Fay discloses the invention substantially as claimed. However, Fay doesn't teach pigments are incorporated into the plastic material. Youmans teaches that it is known to provide numerous plastic lenses, including visors, with pigments incorporated into the plastic material (col.2, lines 9-11 and col.5, line 1-6). Therefore, it would have been obvious to one of ordinary skill in the art to provide Fay's visor with the pigments as taught by Youmans in order to provide a high contrast resolution lens.

Response to Arguments

11. Applicant's arguments have been considered. Applicant submits that Fay fails to teach a "plastic material has a VICAT softening temperature of from 60 degrees C to 140 degrees C....". The VICAT softening temperature is the temperature at which the specimen is penetrated to a depth of 1 mm by a flat-ended needle with a 1 sq. mm circular or square cross-section. Applicant submits that since the claimed performance characteristics of a plastic hat part formed from thermoplastic urethane based on polyether or polyester are not explicitly recited by Fay, then Fay fails to meet the claim. The Examiner respectfully disagrees and submits that: In order for the recited performance characteristics to be given patentable weight, these intended performance characteristics must result in a structural difference between the claimed invention and the structure disclosed by the prior art. The Office does not have the facilities to perform testing on a claimed device, and the performance characteristics of the device

do not carry patentable weight in an apparatus claim. Since Fay teaches the claimed structure, Fay meets the claims as outlined above. Applicant has not pointed to specific deficiencies in the structures of the remaining prior art rejections.

Conclusion

12. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Kmm

March 8, 2007

A handwritten signature in black ink, appearing to read "K Moran", with a stylized, cursive script.

Katherine Moran

Primary Examiner, AU 3765